IN THE

Supreme Court of the United States

RONNING MACHINERY COMPANY and
THE GALION IRON WORKS AND
MANUFACTURING COMPANY,
Petitioners and Appellants Below,

vs.

CATERPILLAR TRACTOR CO.,
Respondent and Appellee Below.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

The Opinions of Courts Below.

The Opinion in the District Court (R. 53-62) is reported in 38 Fed. Supp. 783, that of the Circuit Court of Appeals for the Seventh Circuit (R. 3065) is reported in 129 Fed. (2d) 70.

JURISDICTION.

1. The date of the judgment to be reviewed is May 27, 1942, petition for rehearing denied July 16, 1942 (R. 3071).

2. The statutory provision which is believed to sustain the jurisdiction of this Court is Judicial Code Sec. 240 (a) (28 U. S. C. A. Sec. 347).

3. The facts which show the nature of the case and the rulings below are such as to bring the case within the jurisdictional provisions relied upon, have already been stated in the preceding petition under I (pp. 2-6), which are hereby adopted and made a part of this brief.

4. The cases believed to sustain said jurisdiction are as follows:

Schriber-Schroth Co. v. *Cleveland Trust Co.*, 305 U. S. 47.

De Forest Radio v. *General Electric*, 283 U. S. 664.

III.

STATEMENT OF THE CASE.

This has already been stated in the preceding petition under I (pp. 2-3), which is hereby adopted and made a part of this brief.

IV.

SPECIFICATION OF ERRORS.

1. The Circuit Court of Appeals for the Seventh Circuit erred in holding the Winsor patent not infringed by the Caterpillar Auto Patrol and Motor Graders.

2. The Circuit Court of Appeals for the Seventh Circuit erred in holding the Winsor patent invalid because devoid of invention; and specifically while in effect conceding that Winsor produced a **new combination** of old elements which produced a more efficient machine than **any** prior art machine and one capable of performing a wide range of operations totally incapable of performance by any prior art machine, in holding this **new combination** of old elements was lacking in invention.

3. The Circuit Court of Appeals for the Seventh Circuit erred in not determining the question of infringement by comparing the Winsor patent claims with the accused devices and erred in determining infringement by comparing the accused devices with the specific disclosure of the Winsor patent specification.

4. The Circuit Court of Appeals for the Seventh Circuit erred in treating the Oswald 1919 and the Russell 1920 Machines public use machines as prior art and in not limiting their effect to statutory abandonments, since Winsor was a prior inventor as to each of them.

V.

ARGUMENT.

Summary of Argument.

Point A. Nobody, even including respondent's expert, or his attorney, or either the District Court or the Court of Appeals below, has set forth in any manner how the claims of the Winsor patent fail to read on respondent's accused machines. Petitioners assert with confidence that respondent will not even attempt to point out wherein claims 3, 10, 16, 26, 28 and 31 of the Winsor patent contain any limitations not found in respondent's machines.

Point B. When the Winsor patent was before the Circuit Court of Appeals for the Seventh Circuit in the case of *Galion* v. *Adams,* 105 F. (2) 943, 947 (First Case) it held the Winsor patent claims read clearly and plainly on the **Adams** graders Models 50, 51 and 20. In the second case of *Galion* v. *Adams,* 128 F. (2d) 411, 412, 413, the **same** court held the Caterpillar Auto Patrol and the **Adams** graders (including the above mentioned models as well as others) to be substantially of the same design and construction. Still we find this **same** court in its decision as to which this petition is filed, affirming the District Court and holding the Winsor patent not infringed by the said Caterpillar Auto Patrol.

Point C. The only basis upon which there could possibly be valid rulings that the Winsor patent covers the Adams graders and not the Caterpillar Auto Patrol (the two being of substantially the same design and construction) is that infringement or scope of a patent is determined by one rule against a licensee (Adams) and by another rule against one not a licensee (Caterpillar). No ruling on this exact question by this Court is known, yet

that in the case of *Westinghouse* v. *Formica,* 266 U. S. 342, as well as sound reason, refutes such a proposition. Furthermore, the Court of Appeals for the Seventh Circuit, itself recognized there should be no such distinction in the first *Galion* v. *Adams* case, 105 Fed. (2d) 943, for it stated, P. 947:

> "The claims in plain and unambiguous language cover many different kinds of structures, including models 50, 51 and 20. If the claims are so broad that they cover the prior art, they are invalid, and the court in such case should not attempt to limit them in order to save them."

Following this the decision criticized that of the District Court in the case of *Galion* v. *Beckwith,* 25 F. Supp. 73 and said, p. 947-8:

> "We are unable to agree with the conclusion of the Court for the Western District of Pennsylvania in the *Galion* case as to the power of either the court or the patentee to limit an unambiguous claim by the specification."

Apparently, in the case on petition, said Court of Appeals ignored its own prior recognition of the fact that patent claims should be construed against a licensee and a stranger alike. The rule on **validity** is different.

Point D. In affirming the ruling of the District Court that defendant's accused machines did not infringe the Winsor patent, the Court of Appeals departed from the usual course of judicial proceedings and sanctions such a departure by the District Court. This Court has many times ruled that infringement is to be determined by comparing the patent **claims,** not the specific description of the patent specification, with the accused devices.

Continental Paper Bag Co. v. *Eastern,* 210 U. S. 405, 418, 419.

The Williams Mfg. Co. v. *United Shoe Machinery Corp.,* U. S. Sup. Ct. No. 332, May 25, 1942.

Milcor Steel Co. v. *Fuller et al.,* U. S. Supp. Ct. No. 720, April 27, 1942.

Both the District Court and the Court of Appeals **completely ignored** the patent claims in determining the question of infringement and improperly based their rulings on the specific disclosure of the patent specification description and, in important particulars, entirely misconstrued parts of it.

Point E. (1) The District Court stated that Winsor had made an invention in connecting a tractor at the rear end of a grader to push it, rather than putting it ahead to pull it (38 Fed. Supp. 783, 785). The experts of the Patent Office, in allowing the Winsor patent after extensive prosecution, including two interferences in both of which Winsor was awarded priority over his rivals, had previously ruled Winsor had made an invention.

(2) The presumption of validity attached to the Winsor patent was supported by the strongest evidence to support such a presumption, including the following facts which were ignored by the Court of Appeals.

a. The prior art failed to disclose a single teaching of a power operated blade type road grader with a unitary tractor or power traction unit **at the rear end,** pushing the grader.

b. A grader as defined in (a) above in which the important **3 point connection** was provided between the tractor or power traction unit and the frame, so that distortion of the grader frame under the influence of the grader blade would not be transferred to the tractor or power traction unit to break it, or misalign bearings.

c. The Russell 1920 power operated blade graders (R. 1685 and 2163) that combined a tractor and grader to make a power operated blade grader put the tractor **ahead** of the grader where it had many disadvantages as compared with the Winsor structure. (It was valid only as a 2 year statutory bar).

d. The Russell Grader Co., predecessor to Caterpillar in the road grader business, in making power operated road graders first, about 1920 (R. 67-8; Pls. Exh. F, R. 1685), used a two wheel **unstable tractor** at the **front** in place of the front wheels of the grader; later, about 1923 it used a **four wheel stable** tractor at the **front** (R. 64-5; Pls. Exh. G, R. 1687) and then, in 1924, literally and actually copied the structure previously introduced through Winsor's personal efforts and those of the Wehr and Hadfield-Penfield companies with which Winsor was successively associated. Winsor first reduced to practice in June 1919, his first commercial machine was June 1922. *Ronning Machinery Co.* v. *Winsor,* 76 Fed. (2d) 392.

e. The principal power operated grader relied upon by respondent to show lack of invention, namely the Oswald two year public use, did not combine a tractor and grader but put a motor above the grader blade on the grader frame. **8** or **9** such machines were sold during the history of these machines against **30,000** Winsor type machines. No Oswald type machine has been manufactured for many years (R. 299, 694). (It was also only valid as a 2 year statutory bar).

f. For a number of years respondent paid royalties, totaling in excess of $75,000 under Ronning patent No. 1,706,256 and when Winsor was successful in an interference against Ronning, 76 Fed. (2d) 392, and took from Ronning Winsor's claims 2 to 10, inclusive, and the Winsor patent issued, respondent cancelled its license under the Ronning patent because of the issuance of said claims in said Winsor patent (R. 19-20; 36-37).

g. There is not a single prior art grader which will perform all of the operations Winsor's type of grader will perform (See R. 1595-1609; 1287-1311).

h. Today **all** the large manufacturers of graders are manufacturing Winsor's type power graders to the exclusion of all other types (R. 122-3).

i. All of the large manufacturers of power operated graders have taken a license under the Winsor patent, save respondent, said licensees including Huber Mfg. Co.; Western-Austin Co.; J. D. Adams Co.; Allis-Chalmers Co.; W. A. Riddell Co. and petitioner Galion (R. 411-12; 1653-9).

(3) In holding the Winsor patent invalid the Court of Appeals for the Seventh Circuit ignored the above important facts and rendered an opinion in direct conflict with its prior opinion in the case of *Myers et al.* v. *Austin-Western Road Machinery,* 45 Fed. (2d) 751. There it held such remote devices as tractors with attachments, and agricultural devices were "not in the same inventive field" (Decision page 753) as the Winsor power operated road grader there involved. In the instant case the inconsistent basis upon which said court's holding of invalidity is founded is that since the **individual elements** of Winsor's combination are old, such as tractors, pull type road graders, and three point suspensions in automobiles, they may be combined without invention because a somewhat similar combination is found in agricultural devices; but even they lack a three point suspension, or a **grader blade,** or any other tool which presents the same or equivalent problems presented by a grader blade.

(4) In holding Winsor had failed to make an invention, said Court of Appeals departed from the accepted and usual course of judicial proceedings because:

(a) It clearly lacked any anticipating prior art.

(b) It ignored the established rule of law that a **new combination** of old elements which performs a new function and produces a new result involves invention.

The Williams Mfg. Co. v. *United Shoe Machinery Co., U. S. Supp. Ct.* No. 332, May 25, 1942.

(c) It ignored the well established rule that to justify a holding that claims of a patent are invalid over prior art it is essential to find the exact combination of the patent or its full equivalent in the prior art where substantially the same means perform substantially the same result.

Loom Co. v. *Higgins,* 105 U. S. 580;

Diamond Rubber Co. v. *Consolidated,* 220 U. S. 428.

Point F. As above set forth, except for respondent, all of the large manufacturers of power operated road graders have taken a license under the Winsor patent, consequently unless the decision of said Court of Appeals is reviewed and reversed Winsor and those supporting him will probably have no other chance to litigate his patent. Winsor is a poor man, dependent on income from this patent (R. 302, 349). This independent inventor made his reduction to practice in 1919 on a farm in Northern Michigan entirely without aid from any corporation and without financial assistance (R. 267, 275). Later (1922) a small company, the Wehr Company, first commercially produced his invention under Winsor's supervision. Until shortly before his patent issued **none** of the large manufacturers paid any attention to his **rights.** They **all** paid considerable attention to his invention (R. 548-9). Unless the decision of said Court of Appeals is reversed **the solemn promise of the United States Government** made when his patent was granted, will be a nullity and Winsor will fall a victim of that growing conviction among independent inventors that a large corporation willing to spend limitless money can successfully appropriate almost **any invention** and those who champion the rights of inventors and spend money to support **that which the government promised them** would be better advised to join the ranks of the appropriators, even though the

prior art lacks any true teaching of the thing patented, and invention, as measured by true tests recently again approved in the case of *The Williams Mfg. Co.* v. *United Shoe Machinery Corp.,* U. S. Supp. Ct. No. 332, May 25, 1942, be present.

Point G. A prior use, operating only as a statutory bar under R. S. 4886, and not showing prior invention, is not on the same footing as a prior invention and properly should be limited to essentially the exact thing which it discloses or embodies.

COMPLETE ARGUMENT.

Petitioners shall only elaborate, when necessary, to support the Summary of Argument and will do so under headings there used.

Point A. For a brief description of the Winsor patent, respondent's Auto Patrol and Motor Graders and the Adams Motor Graders, respondent adopts the language of the Circuit Court of Appeals for the Seventh Circuit in the case of *Galion* v. *Adams,* 128 F. (2d) 411 (Second case) p. 413.

> "Both the Caterpillar products held not to infringe and defendant's (Adams) graders are power operated machines with a relatively long vehicle frame comprised of spaced, elongated, symmetrically arranged side members and cross members, with a power traction unit at the rear and a steering unit at or near the front end of the frame. Each has a grader blade adjustably mounted on the frame to operate on material along the path of travel. Each has a mechanism between the side members and the power unit to hold the implement in a fixed relation to the frame, independent of the steering wheel unit. In both the engine

is supported at three spaced points upon the frame. Each has the operator's station between the engine and the grader blade, except that in a few models of defendant's graders it is located over and to the rear of the motor. And both place their engines over the axle except in a few models of defendant. These slight differences are of no importance."

Petitioners also respectfully direct attention to Chart A showing these several machines, and containing claims 3, 10, 16, 28 and 31 of the Winsor patent.

What limitation in **any** of these claims fails to find response in the Caterpillar graders? **None** is set forth by either court below. **None** is lacking.

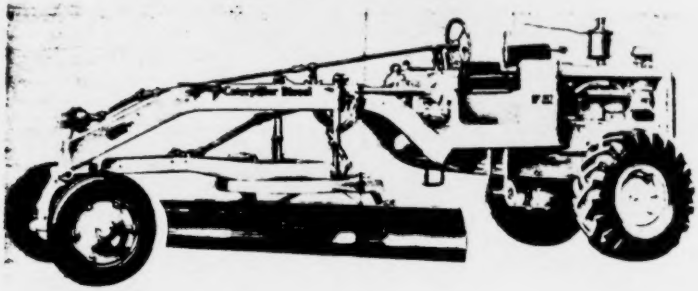
Point B. Having ruled directly in said second case of *Galion* v. *Adams* that the Adams and Caterpillar machines were the same, **as obviously they are.** (For record illustrations of these several machines see, Caterpillar machines R. 1539, 1541, 2073: Adams R. 1277-83; Winsor R. 1269; 1311; 2298); no explanation is given, or is possible to reconcile the holdings of both the District Court and said Court of Appeals that these claims do not cover the Caterpillar graders, with the holding of said Court of Appeals in the **first** *Galion* v. *Adams* case, 105 Fed. (2d) 943, 946-948, wherein said Court of Appeals stated:

"The question here presented is whether any of appellant's last three models (50, 51 and 20) embody one or more claims of the Winsor patent No. 2,020,271.

However, it is obvious that one or more of the claims involved reads literally upon each of the models here in question. Appellant seeks to parry the force of this situation by having the court limit the claims by the language of the specification to a means for coupling a tractor in a road grader in such a manner that the tractor may be detached from the

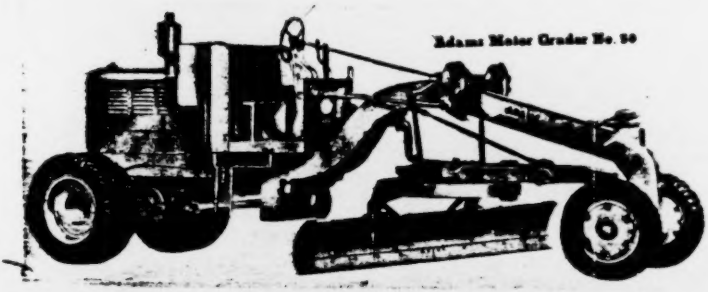
CATERPILLAR MOTOR GRADER

PLAINTIFFS' EXHIBIT 574



ADAMS MOTOR GRADER No. 50

PLAINTIFFS' EXHIBIT 525



THE CLAIMS IN PLAIN AND UNAMBIGUOUS LANGUAGE COVER MANY DIFFERENT KINDS OF STRUCTURES, INCLUDING ADAMS MOTOR GRADER No. 50. GALION V. ADAMS—105F 2d 943, 947.

Claims of the Winsor Patent sued upon—2, 22, 23, 24, 26,

3. The combination with a tractor, of a frame secured to and extending forwardly from the tractor, a wheeled support for the forward end of the frame, a grader blade adjustably carried by the frame rearwardly of the support, an operator's station, and controls extending from said wheeled support and from said grader blade to within reach of the operator at said station.

10. The combination with a tractor, of a frame attached to the tractor and extending in front thereof, a steering wheel unit applied to and supporting the front portion of said extended frame, a road grading tool connected to said frame and working at the rear of said steering wheel unit but ahead of said power unit, and controls, extending to within reach of the tractor operator, for raising, lowering and angularly adjusting said road grading tool, and for steering said steering wheel unit.

16. The combination with power traction mechanism comprising a rear axle housing and ground engaging traction devices operatively connected through said housing to an internal combustion engine, of a frame mounted on said traction devices and extending forwardly in advance thereof, a steering wheel unit at the front portion of said extended frame, a road working implement connected to said frame and adapted to work at the rear of said steering wheel unit, a supporting connection between said internal combustion engine and said frame, means for controlling said road working implement, and means for operating said steering wheel unit both during the operation of said power traction mechanism.

28. In a power road grading machine, the combination with a relatively long vehicle frame comprising spaced-apart side members continuously longitudinal from the front end of the machine to the rear end thereof, of a power plant

HART A

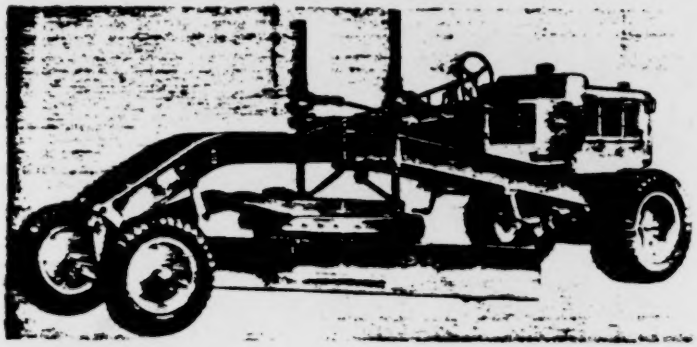
3, 4, 5, 6, 7, 8, 9, 10, 11, 13, 14, 15, 16, 19, 20, 27, 28, 29, 30 and 31.

engine from an ordinary tractor of standard type of construction connected to said frame, ground engaging traction devices connected to said power plant engine to be driven thereby, a supporting connection between said engine and said frame side members, a steering wheel unit for one end of said frame, an elongated grader blade adjustably suspended from said spaced-apart side members between said steering wheel unit and said traction devices to occupy a diagonally extending position transversely of said side members and spaced below the same at the road surface, an operator's station, and means for controlling the operation of the grader blade and the operation of the steering wheel unit.

31. In a power operated road machine, the combination with a relatively long vehicle frame comprising spaced-apart elongated symmetrically arranged side members, of a power traction unit at one end portion of said frame and comprising an engine connected by power transmission mechanism to ground engaging devices, a steering wheel unit at the other end portion of said frame, a road working implement adjustably mounted on said frame in position to operate on material along the path of travel of the machine, mechanism between the said spaced-apart side members and the forward central portion of said power traction unit to hold the latter in fixed relation to said frame independently of said steering wheel unit, the power traction unit being otherwise supported solely by said ground engaging traction devices, spaced-apart supporting connections between the said spaced side members and said ground engaging traction devices to afford support of said frame solely by said traction devices and said steering wheel unit and provide connections at three spaced points between the frame and the power traction unit, an operator's station, and means operable from said operator's station for adjusting the working implement and actuating said steering wheel unit during movement of the machine along the roadway by means of said traction unit.

CATERPILLAR AUTO PATROL

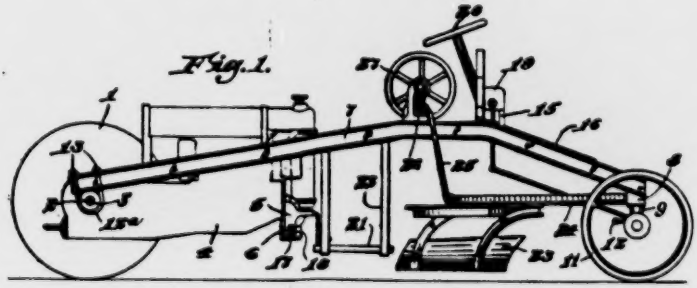
PLAINTIFFS' EXHIBIT 571



"The gasoline engines used in the No. 11 and No. 10 Auto Patrols are the same successful design as those used in 'Caterpillar' Gasoline tractors." (Pls.' Exh. 195, p. 21, R. Vol. 2, p. 1237.)

"The engine and transmission form a sturdy compact unit mounted in a three point suspension in the grader frame."
(Pls.' Exh. 573, ~~Brief-Appendix.~~)

FIGURE 1 OF WINSOR PATENT 2,020,271



grader and restored to its original uses. If this contention is sound, the next contention is that the claims as thus limited do not read upon appellant's structures, because they are unitary in character, and the tractors used therein may not be detached from the grader and used as a truck. We do not question the court's power to interpret ambiguous language of claims, but we do not understand that the court has the power by judicial decree to limit any claim that is not ambiguous, merely because there is an inconsistency between it and the specification. Here the claims in plain and unambiguous language cover many different kinds of structures, including models 50, 51 and 20. If the claims are so broad that they cover the prior art, they are invalid, and the court in such case should not attempt to limit them in order to save them. That question, as before stated, is not in issue and we cannot approve the District court's findings that they are valid.

In the *Galion* case, *supra*, (*Galion* v. *Beckwith*, 25 Fed. Supp. 73) no license was involved and the court was at liberty to hold either that the claims were invalid or that they were not infringed. It concluded that it was unnecessary to pass on the validity of the claims, and concluded to limit them to what it regarded as a precise disclosure of the specifications. It then found there was no infringement and cited our ruling in the case *Myers* v. *Austin-Western Road Machinery Company*, 7 Cir., 45 F. (2d) 751. We express no opinion here as to the claims thus limited. We merely hold that the claims as they stand are infringed by each of appellant's structures here in issue, citing claim 16 as typical. We are unable to agree with the conclusion of the court for the Western District of Pennsylvania in the *Galion* case as to the power of either the court or the patentee to limit an unambiguous claim by the specification.

Furthermore, we indicate no opinion as to whether any of the claims are too broad. Such a holding would

render the claims invalid and that issue is not before us. We merely hold that the claims as they stand are unambiguous and that they cover the accused devices."

How can the public know what the rule as to interpretation of patent claims is, if such conflicting decisions are rendered by a United States Court of Appeals, unless rectified?

Point C. Elaboration of this point is deemed unnecessary. Its logic is basic.

Point D. It is a significant fact that neither the District Court in its decision nor said Court of Appeals discusses **any claim,** or any limitation in any **claim** of the Winsor patent and neither decision points out any limitation in any claim that finds no response in respondent's machines. A clearer case of a departure, by both said courts, of the long established and recognized procedure to be applied to determine infringement could scarcely be found. Parts of the decision of the District Court, apparently sanctioned by said Court of Appeals, are unusually flagrant. For example, the District Court in its Finding of Fact No. 7 (R. 2223, 38 Fed. Supp. 783, 788) held:

> "The only novelty residing in the plaintiff's patent rests in the means for coupling any of the well-known Tractors with an ordinary road-working machine, and thus supplying the motive power to operate the road machine, and **still have the tractor for use for other purposes when it is not utilized as a road machine.**" (Emphasis added).

The **history** of this finding is interesting. It was **not** proposed by respondent **in this case.** It was **originally** finding No. 10 made in the case of *Galion* v. *Beckwith,* 25 F. Supp. 73 (R. 2025). Being aware of this **clearly erroneous** find-

ing in said *Beckwith* case, respondent's expert was examined directly with respect to it **and admitted** there was no teaching in the Winsor patent that the **tractor** could be removed for other uses (R. 986-7).

Point E. (1) The Winsor file history (Pls. Exh. 530; R. 1321-1515) reveals one of the most startling instances of continuous, varied and burdensome obstacles ever put in the path of an inventor seeking a patent. It shows Winsor was required to go through two protracted and expensive interferences, first with Myers and then with Ronning, consuming about 7 years' time, and obviously great expense. Winsor won both interferences (R. 1374, 1451, 1468). *Ronning Machinery Co.* v. *Winsor,* 76 Fed. (2d) 392. In connection with a case bearing similar facts this Court stated:

> "A patent regularly issued, and even more obviously a patent issued after a hearing of all the rival claimants, is presumed to be valid until the presumption has been overcome by convincing evidence of error. The force of that presumption has found varying expression in this and other courts * * * through all the verbal variances, however, there runs this common core of thought and truth, that one otherwise an infringer who assails the validity of a patent fair upon its face bears a heavy burden of persuasion, and fails unless his evidence has more than a dubious preponderance. *Radio Corporation* v. *Radio Engineering,* 293 U. S. 1, 7, 8."

(2) (a) In holding Winsor made no invention said Court of Appeals had no basic patent or prior art machine showing the equivalent of Winsor's combination including a tractor or power traction unit at the rear end of a blade grader. Without attempting to analyze each prior art device relied upon it will suffice for this petition merely to point out the following with respect to the prior art relied upon by said Court of Appeals.

Moats 581,606, April 27, 1897 (R. 2358-66). This is merely an extremely old drawn type grader without any kind of motive power.

Godley 899,215, Sept. 22, 1908 (R. 2456-60). This is an agricultural device. Here the weight of the harrow alone is used. Nothing holds the harrow **down.** In a Winsor power grader, **great weight** is added to the big scraper blade to **hold it down.** The **tractor** at the rear is a source of much of this weight. Also the **angular position** of the grader blade relative to the line of travel places a great **side thrust** on the frame which must be, and is, resisted by the tractor. Nothing like this exists in Godley. Also, in a Winsor power blade grader, the blade tends to lift the front wheels and cause loss of steering which is also resisted by weight of the tractor. Godley has no such problem. The Court of Appeals was therefore **right** in the case of *Myers* v. *Austin-Western,* 45 Fed. (2d) 751, when it ruled agricultural devices in a different inventive field. Obviously it cannot do any road grading work. No Winsor claim reads on it. The harrow cannot be adjusted from the operator's station, nor can opposite ends thereof be independently adjusted.

Dawson 982,480, Jan. 24, 1911 (R. 2462-4). This patent is in the same category as Godley. Besides, the front steering wheel, the patchwork main frame, and the plow suspensions are totally inoperative (R. 1117-19). This is truly **a nightmare on paper.** The **practical history** of this device is a vacuum.

Ronning 1,340,461, May 18, 1920 (R. 2762-2805). The remarks above made with respect to Godley fully apply.

Oswald's 1919 machine (R. 1988-89). This is probably the closest machine (Winsor was a prior inventor but this device is a bar **for what it shows** because of

2 years' prior public use). It has no tractor or power traction unit at the rear. The motor is on the grader frame directly **above** the blade where (a) its adjustability is very limited and (b) it cannot be seen by the operator. The different types of work it can do are much more limited than those performed by Winsor machines. For example, by reference to Pls' Exh. 575 (R. 1595-1609) which illustrates numerous typical operations performed by Winsor type machines, the Oswald machine cannot do "Ditching" (R. 1597, 708), or "Road Mix" (R. 1603, 1092-3), or "Snow Removal" (R. 1601, 1091). That is probably why only 8 or 9 of them were ever sold (R. 694) and some **30,000** Winsor type machines have been sold (R. 299). Why doesn't respondent make Oswald type and not Winsor type machines?

Fossum 1,235,456, July 31, 1917 (R. 2612-20). This is not a **blade** type grader. This inventor condemns the **blade** grader (R. 2619, lines 72-80) and then illustrates another nightmare on paper that the **grader industry never heard of** in a practical sense. **None** was ever sold, so far as the record discloses. It can't do "Ditching" (R. 1597); "Road Mix" (R. 1603); "Snow Removal" (R. 1601) or even "Light construction" (R. 1607). There is no mechanism to hold the endless cutter **down** (R. 1046) and all of the deficiencies of Dawson's agricultural devices, above set forth, apply to this structure.

(2) (b) The three point suspension between the tractor or power traction unit and the grader is totally lacking in any equivalent prior art. The purpose of this feature is emphasized by respondent in advertising its Auto Patrol (R. 2073-4). Briefly they are, as follows:

The large blade of a grader does very heavy work at times and is held down by the combined weight of the

tractor unit and the grader frame. This blade in doing heavy work often strikes stones, roots or hard spots and produces stresses, strains and twisting of the grader frame. To prevent these being transmitted to the tractor, whose parts are largely castings and where shafts and bearings are aligned to close tolerances, is the function of the three point connection. The record establishes that in the early days the Western-Austin Company brought out a grader of the Winsor type **without** the three point connection as shown in Beatty patent No. 1,537,328 (R. 2932-48) and that it was a failure because lacking this feature and was abandoned (R. 293-5; 364-6). Lacking this important teaching **in the grader art,** or even in agricultural implements, the Circuit Court lifts it from the entirely remote **automobile art** in the Ruemelin patent 894,-060, July 21, 1908 (R. 2440-47) where it is found purely as an incidental feature and wherein **nothing** equivalent to a grader blade is present. To **combine** in the Court's mind, such patents which were never combined in practice, as a basis for overruling the presumption of validity attached to Winsor patent, is certainly a departure from recognized practice which requires correction.

(2) (c) The Russell 1920 grader is the **only** combined tractor-blade grader unit of record. It is a 2 year statutory bar for what it shows (R. 2163).

This machine represents what the Caterpillar engineers considered the way to combine a tractor and grader to make a power operated grader in 1920. (Caterpillar took over the Russell company in 1928, R. 64-5). Instead of showing lack of inventive imagination and genius in Winsor, this is the strongest evidence of Winsor's inventive genius that could be produced. It is not only significant that the Russell company engineers considered this to be the way to **combine** a grader and tractor to provide

a power operated grader in 1920, but Galion's engineers did the same thing about the same time (R. 1649; 379-81). Here the tractor is substituted for the **front wheels** of the pull type grader.

When this machine didn't work satisfactorily, was it obvious to the Russell and Galion engineers to put the tractor at the rear? No it was not, they **both** then tried a four wheel tractor **at the front.** (See Pls.' Exh. G, R. 1687; 64-5; R. 409-11 and R. 1533; 380-1).

After the Winsor machine came on the market, being introduced by **two new companies,** the Wehr Company and then the Hadfield-Penfield Steel Co. (R. 548-9; 355-57), and the established road grader manufacturers were losing business to them, it **was then obvious** that Winsor's construction was the best one, so Caterpillar's predecessor and Galion, as well as the rest of the large grader manufacturers, copied the Winsor design and abandoned all others, including this Russell 1920 type (R. 381).

The advantages of the Winsor type over this Russell 1920 type may be summarized as follows:

In the Winsor type,

(1) the weight of the tractor holds down the rear end of the grader so that considerable weight can be applied to the blade or moldboard to force it into the ground. The weight also aids in steering and holds the rear end against lateral thrust by the diagonal blade (R. 582-3).

(2) Since in this type of machine the traction wheels are ahead of the grader blade, said traction wheels travel on rough, and sometimes soft muddy ground, while in the Winsor type machine the wheels travel over ground which has been smoothed off and prepared into a level surface by the blade ahead of them (R. 129).

(3) It is almost impossible to back up such a machine because there is essentially a one point connection between the grader and tractor and consequently the machine will buckle if attempt is made to reverse it (R. 380-1).

(4) Steering is very hard and the machine is poorly balanced because to steer it the whole tractor must be turned relative to the grader, while in Winsor machines the front wheels are steered like an automobile.

(5) The long controls from the tractor unit to the rear of the grader are very unsatisfactory and when the grader travels over rough ground they bind or operate improperly (R. 380).

Considering the functions of such a machine as compared with Winsor type machines, it is useless for "Ditching" (R. 1597); "Snow Removal" (R. 1601); "Towing" (R. 1605) or even "Light Construction" (R. 1607).

These Russell 1920 type machines are useful only for light maintenance and possibly finishing work. All heavy digging and grading is beyond their capacity.

(2) (d) The record shows that the practical power operated road grader dates from Winsor's introduction of his grader to the industry in 1922 after his earlier reduction to practice in 1919 (R. 549, 431-53). When Winsor's machine was first introduced the road grader fraternity did not think well of it and generally treated it as a joke (R. 362-4; 409-11; 381). At that time the Russell 1920 type was considered by the skilled engineers to be the best and this was followed by a similar machine using a four wheel tractor at the front in place of a two wheel tractor (R. 64-5; 380-1).

(2) (e) to (i) Nothing need be added to the Summary under these headings.

3. In the case of *Myers et al.* v. *Austin-Western,* 45 Fed. (2d) 751, the Court of Appeals for the Seventh Circuit, had before it the question of infringement of Austin-Western graders which the court stated was the Winsor grader "with immaterial differences" p. 752. (For an illustration of this grader see R. 1255-57). Myers was claiming infringement of his patents Nos. 1,399,570 (R. 2832) and 1,466,098 (R. 2908) on tractors with attachments and a power driven agricultural device. Said Court of Appeals held the Winsor road grader not to be "in the same inventive field" (Decision pp. 753 and 755) and this is correct, yet in the case under petition said Court of Appeals resorts to the remote agricultural devices of Godley, Dawson and Ronning 1,340,461 for a teaching of a tractor at the **rear end** of a grader. Only in such remote art, is a tractor found so positioned, **and then without** the important three point connection.

4. The summary need not be enlarged.

Point F. During the years that Winsor struggled through successive interferences, appeals, petitions, etc., in the Patent Office the **grader industry generally ignored his rights.** Winsor received no royalty, except $5.00 a grader from the Hadfield-Penfield Steel Co., his original licensee, and its successor, the W. A. Riddell Company. The large manufacturers had, since about 1924, deliberately copied his machines, but Winsor was involved in interference with Ronning, so why should anyone worry about him until he defeated Ronning?

Shortly before the Winsor patent issued, Galion paid $50,000.00 cash for an exclusive license under it to the receiver for the W. A. Riddell Company (R. 772, 776) and an agreement was made with Mr. Winsor to pay him

$10.00 a grader. This was the first act by an established strong manufacturer to recognize Winsor's rights. When the Winsor patent issued, licenses were offered to all the established road grader manufacturers, including respondent (R. 1779-80) and most of them, including all of the larger ones, except respondent, took a license (R. 1653-9).

If the judgment of the Court of Appeals is not reversed, Winsor's promised source of income from his invention will cease (R. 349).

Point G. It is an important fact that the only two power operated blade graders relied upon by the Court of Appeals, namely the Oswald 1919 machine (R. 1988-89) and the Russell 1920 device (R. 2163) are not truly prior art, yet in its decision the said Court improperly made no distinction between them and true prior art but remote devices. The Russell 1920 device was **directly** relied upon and **reconstructed** in the Court's mind to show **lack of invention** (R. 3069) 129 Fed. (2d) 70, p. 72, Petitioner is aware of no decision of this Court which settles this important question.

Section 4886, R. S. (U. S. C. title 35, Sec. 31) may properly be segregated into two parts. The first part is the general grant which provides that:

> "Any person who has invented or discovered any new and useful art, machine, etc.,—not known or used by others in this country before his invention or discovery thereof * * * may, * * * obtain a patent therefor".

If this was all the statute provided, Oswald's October 1919 public use or publication (being subsequent to Winsor's established reduction to practice in June of 1919) and the Russell 1920 one man grader would have **no effect** and be unavailable against Winsor.

However, the general grant of said statute is restricted in that any device "in public use or on sale in this country more than two years prior to his application" (since reduced to one year) bars a patent on such device. In short, such a public use or sale acts as a dedication or forfeiture of **that device** insofar as it incorporates any part of the thing sought to be patented. It is a restriction on the general grant of a right to a patent. As such a restriction or dedication, it must be strictly construed and limited to the precise thing embodied in the public use. In the instant case it means that Winsor is entitled to **no claims** in his patent which read on Oswald or Russell and he obviously has none. Beyond that, Oswald and Russell have no limiting effect on Winsor, yet they were strongly relied upon by the Court of Appeals in a much broader respect, namely, to show **lack of invention** in Winsor as though they were truly prior art patents. *Ex parte Derby,* 1884, C. D. 21, and cases cited; *Emery, et al.* v. *Cavanagh,* 17 Fed. 242; *Jockmus* v. *Gale,* 295 Fed. 208; *Ide* v. *Trorlicht,* 115 Fed. 137; *Remington* v. *National,* 6 F. (2d) 585, 612; Walker on Patents, Deller Edition, pages 372, 3, Section 99, and cases cited.

As stated by this Court in *James* v. *Campbell,* 104 U. S. 356, 379:

> "The **same combination** of postmarker and blotter in one instrument was also exhibited in Norton's own patent of Aug. 9, 1859. As he did not then reserve the process of stamping letters with such an instrument, nor the combination of a post-marker and a blotter, and did not make any simultaneous application therefor, he could not afterwards obtain a patent for such process and combination, but would be restricted to such particular combination or process as might be exhibited in a new device or apparatus."

As stated in Robinson on Patents, Sec. 360, p. 515:

> "The public use or sale of an invention works an abandonment only of the exact invention used or sold", citing numerous authorities.

In the leading case of *Smith and Griggs Mfg. Co.* v. *Sprague,* 123 U. S. 249, 265-6, this Court stated:

> "The patentee unduly neglected and delayed to make his application for the patents, and deprived himself of his right thereto by the public use of the machine in question, so far as it is embodied in the claims under discussion".

Other claims, not reading on the public use, were held valid.

See also *Star Mfg. Co.* v. *Crescent Forge & Shovel Co., et al.,* 179 Fed. 856 (C. C. A. 7).

That a public use bars only claims which read on it, and not improvements, is recognized in the case of *National Biscuit Co.* v. *Crown Baking Co.,* 105 Fed. (2d) 422, 427 (C. C. A. 1) wherein the Court stated:

> "All that has been shown on the favorable view of the evidence is that the 1920 machine was not operatively perfect. This is immaterial as regards claims 1, 6, 15, 19, 26, 36, 39, 46, 61 and 83, which read upon the 1920 machine and are not limited to any addition or improvement."

Other claims of the patent, not reading on said public use, were held valid.

Respectfully submitted,

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